

REMARKS

Claims 1 to 28 and 31 to 33 are pending, of which Claims 1, 11, 16 and 24 are independent. Claim 1 is amended. Reconsideration and further examination are respectfully requested.

By way of an introduction and a non-limiting example, one or more embodiments have application in an advertising industry that serves ads via a network to a user computer, and desires to monitor the effectiveness of served ads. Any of a number of measures might be used in monitoring an ad's effectiveness, including capturing the number of times the ad is viewed by a user (often referred to as a "page view"), the number of times a user activates a link in the ad to the advertiser's web page (often referred to as a "click-through"), the number of times a user makes a purchase after activating a link in the ad (often referred to as an "acquisition").

In accordance with a conventional approach described in the present application, an "ad-serving entity" receives advertising content from advertisers or agencies, and uses a staff of programmers to incorporate received ad content into ad code before the ad content is served to a user computer. This process must be repeated any time the ad content and/or ad code changes. Such work is labor intensive and results in both decreased profits for the entities serving the ads and, to the extent the cost is not completely absorbed by the entity serving the ad, increased advertising costs to the advertiser and/or agency.

In accordance with aspects of the claims, by way of non-limiting example, an integrated ad file, which is served to a computer to provide the ad, is created by combining an ad input file, which identifies ad content, with a conduit file, which comprises computer code to provide the ad and to identify ad tracking code. With this arrangement, an advertiser may provide the content to any number of different ad-serving entities without concerning itself with the ad tracking methodologies that are to be used with the content. Similarly, a tracking methodology can be selected and implemented independent of the ad content. On one hand, advertisers may modify the ad content without implicating changes to the tracking code, and on the other hand, modifications can be made to the tracking methodology and code without implicating changes to the ad content.

By way of a non-limiting example and with reference to Figure 5 of the present application, in accordance with one or more embodiments, an ad input file, e.g., ad input file 504, is combined with a conduit file, e.g., conduit file 506, using a merge tool 502 to automatically create an integrated ad file prior to serving the integrated ad file from a computer. The merge tool 502 automatically creates integrated ad file 204 using the ad input file 504 and the conduit file 506, wherein the ad input file 204 identifies the content of the ad and the conduit file comprises computer code to provide the ad and to identify tracking data for the ad. Reference is respectfully made to Figures 6 to 9 of the present application. Figure 6 illustrates a portion of an exemplary ad input file 502, and Figure 8 provides an example of an integrated ad file 204 portion that includes the contents of the exemplary ad input file 502. As is described in paragraph 28 of the present application, the ad input file includes the contents of the ad. Figure 7 illustrates a portion of an exemplary conduit file 506, and Figure 9 illustrates a portion of the integrated ad file 204 portion that includes the exemplary conduit file 506. Referring to paragraph 32 (n.b., the paragraph numbering used herein corresponds to that used in the present application's publication, U.S. Publ. No. 2004-0117259) of the present application,

the integrated ad file 204 includes code (incorporated from the conduit file also described below) that pulls the value of the "targID" variable and, depending on the value of the variable, either provides the ad in a new window or in the same window.

With reference to Figure 7 and paragraphs 35 and 43 to 52, in accordance with at least one embodiment, the exemplary conduit file includes computer code that "builds the redirection URL used in tracking," includes code that "references variables that are populated by the html code 202," such as "targID," which is used by the code in the conduit file to determine whether or not the ad is provided in a new window, and code that can accommodate multiple exit URLs. In addition and with reference to paragraph 52, in accordance with at least one embodiment, the conduit file can include additional text that can be used to facilitate identification of ads served using the integrated ad file, which contains the conduit file. In other words, the conduit file includes code that can be integrated with an ad input file in an integrated ad file, e.g., using the merge tool 502, to add functionality to the integrated ad file, e.g., building a redirection URL,

providing an ad, and/or adding unique identification information to allow for more meaningful tracking information.

As is described commencing at paragraph 28, the integrated ad file can be served from a computer in response to a user 112 accessing a web page, which includes HTML code, e.g., HTML code 202, for loading the integrated ad file, and includes variable and parameter information that is passed to the integrated ad file. The HTML code used to load the integrated ad file and pass information to the integrated ad file is not the integrated ad file.

The Office Action rejects Claims 1 to 10 under 35 U.S.C. § 112, first paragraph, and contends that the specification does not disclose a conduit file that comprises computer code to provide the ad and to identify tracking data for the ad. Based on the above discussion and references to the specification, the Applicant submits that the specification discloses a conduit file that comprises computer code, and further discloses a conduit file that comprises computer code to provide the ad. Reconsideration and withdrawal of the § 112, first paragraph rejection are respectfully requested.

Claims 1, 4, 7 to 10 and 33 are rejected under 35 U.S.C. § 102(b) over a white paper by Solbright entitled “The Inside Edge on Rich Media Partnership Series” (referred to herein as Solbright), and Claims 2, 3, 5, 6, 11 to 28, 31 and 32 are rejected under 35 U.S.C. § 103(a) over Solbright and the Official Notice taken by the Examiner. Reconsideration and withdrawal of the rejection are respectfully requested for at least the reasons set forth below.

The Applicant’s previous response requested the Examiner to provide the necessary support for the Official Notice taken by the Examiner. While the Examiner maintained the rejection and continues to rely on Official Notice in the current Office Action, the Examiner did not provide the necessary support requested by the Applicant. As is discussed more fully below, the burden remains with the Examiner to provide the requisite support for the Examiner’s grounds of rejection. The Applicant renews its request that the Examiner provide the requisite support for the Official Notice, should the Examiner continue to rely on Officially Noticed facts. For at least the reasons provided below, however, the Applicant submits that the grounds for rejection should be withdrawn.

Claim 1 recites a method for providing an ad via a computer network. According to the method, an ad input file is combined with a conduit file using a merge tool to automatically

create an integrated ad file prior to serving the integrated ad file from a computer. The ad input file identifies the contents of the ad and the conduit file contains computer code for providing the ad and for identifying tracking data for the ad. The integrated ad file contains both the ad input file and the conduit file contents and is served from a computer to provide the ad.

Solbright fails to teach, suggest or disclose numerous claim elements, including a conduit file, combining a conduit file with an ad input file, a merge tool that is used to automatically create an integrated ad file by combining an ad input file with a conduit file prior to serving the integrated ad file, and/or serving an integrated ad file automatically created by combining the ad input file and the conduit file using a merge tool.

The Office Action cites pages 17 to 19 of Solbright and states that:

“Solbright teach integrating an input file (Flash ad) and conduit file (tracking code) and creating an integrated ad file from a computer to provide an ad.”

As is described in the cited portion, Solbright requires that someone, such as a programmer, modify the ad file to include the “getURL(clickTag)” action in the ad file. See, for example, the process described at page 18 of Solbright. The Examiner concedes that Solbright requires that a Flash ad be manually edited. More particularly, in the stated grounds for rejecting Claims 2, 3, 13, 14, 22, 23 and 28 found at page 5, the Examiner states that Solbright describes “designers creating their ads and developers or programmers adding the tracking string after the ads are created.” It is clear that Solbright suffers from the same conventional shortcomings described in the background of the present application and discussed above. In order to track an ad, for each Flash ad file, Solbright’s approach requires that a programmer edit the ad file to add the getURL action code to the Flash ad file. Solbright requires that a programmer manually edit the ad file to add the GetURL action code to the ad file. According to Solbright, each ad file must be manually edited before it can be used with Solbright’s approach. In addition and in order for a new ad file to be used with Solbright’s approach, it must be manually edited. In stark contrast, as claimed, an ad file need not be manually edited, since the subject matter of the present claims automatically creates an integrated ad file by combining, using a merge tool, the ad input file with a conduit file that comprises code to provide the ad and identify the tracking data. The integrated ad file, which is automatically created using the merge tool prior to serving

the integrated ad file from a computer, comprises the contents of the ad input file that identifies the content of the ad and the contents of the conduit file that comprise computer code to provide the ad and to identify tracking data.

Notwithstanding the automatic creation discussed above, Solbright does not disclose or even suggest a conduit file, let alone the claimed conduit file, which comprises computer code to provide the ad and to identify tracking data, and which is combined with an ad input file by a merge tool in order to enable the automatic creation of an integrated ad file that is served to provide the ad. Solbright's Flash ad must be manually modified to include the getURL code that retrieves a URL from Solbright's HTML wrapper file, and nothing in Solbright even mentions a conduit file. While the Examiner contends that "tracking code" corresponds to the claimed conduit file, as is clear from the concessions made by the Examiner in the Office Action discussed above, tracking code *per se* cannot and does not disclose or even suggest a conduit file, let alone a conduit file which is automatically combined with an ad input file using a merge tool to create an integrated ad file as is recited in Claim 1. Furthermore, there is nothing in the grounds for rejection or the Examiner's response to the Applicant's previous remarks that identifies what element of Solbright the Examiner considers to correspond to the claimed integrated ad file. Solbright's Flash ad that is manually edited cannot be said to be the same as an integrated ad file that is automatically created using a merge tool that combines a conduit file with an ad input file. Nothing in Solbright teaches, suggests or discloses combining an ad input file and a conduit file to create an integrated ad file, combining an ad input file with a conduit file using a merge tool to automatically create an integrated ad file, and/or combining an ad input file with a conduit file using a merge tool to automatically create an integrated ad file prior to serving the integrated ad file from a computer. Solbright's requirement to manually edit the ad file is separate from, and in addition to, any edits that a programmer makes to Solbright's HTML wrapper file. Solbright's HTML wrapper file loads the ad file and passes a tracking location to the getURL action code that must be manually added to the ad file. Solbright's technique of using an HTML wrapper file to pass a URL to Solbright's ad file requires that Solbright's ad file be manually edited to add the getURL action code to Solbright's ad file. Furthermore, Solbright's HTML wrapper passes the URL to the ad file only after both the ad file and the HTML wrapper have been served to the user computer, after the ad is displayed in a browser

window of the user's computer, and after the user provides button input in connection with the displayed ad. An HTML wrapper that is only accessed after a Flash ad is served and displayed to a user computer, and after the user interacts with the displayed ad is quite different technically, and therefore it cannot reasonably said to correspond to the claimed conduit file or the claimed integrated ad file, the latter of which is automatically created by combining the claimed conduit file with the claimed ad file using a merge tool and served from a computer to provide an ad.

The Examiner's comments found at page 8 of the current Office Action state the following:

According to applicant's subject matter the advertiser creates the content of the ad (504) and the portal uses the merge tool 502 to combine the content of the ad input filed (provided by the Advertiser) and [the]conduit file (tracking code created by the portal). Therefore, the tracking code [is] created and added to the ad file at the server, same as the prior art; the same as creating an HTML wrapper file that uses the <OBJECT> and <EMBED> tags to pass the appropriate parameters for the tracking string to the ad and then each publisher will need to modify this file (wrapper file) to insert their own, unique tracking code (same as applicant merge file to add the tracking code (conduit file)).

The Examiner's position assumes facts that are not supported by Solbright. Solbright's HTML wrapper file contains HTML code that passes a URL to Solbright's ad file after both the ad file has been served to the user computer. Solbright's HTML wrapper file is never combined with an ad input file to create an integrated ad file. As is recited in the claims of the present application, a conduit file is combined with the ad input file using a merge tool to automatically create an integrated ad file. Solbright's HTML wrapper file and ad file are discrete files that are served separately. Furthermore, Solbright's parameter passing, which passes a value from the HTML file to Solbright's ad file, occurs at the client computer after the HTML file and the ad file have been served, after the ad is displayed in a browser window of the user's computer, and the user interacts with a button displayed in the browser window to provide button input in connection with the displayed ad. Solbright never combines its HTML file and its ad file to

create an integrated ad file, and in fact never combines its ad file with any other file to create an integrated ad file. Solbright does not teach, suggest or disclose a conduit file that comprises computer code to provide the ad and to identify tracking data for the ad. Solbright cannot therefore create an integrated ad file by combining a conduit file with an ad file, and further cannot serve an integrated ad file that is created by combining an ad input file with a conduit file.

For at least the foregoing reasons, Claim 1 is believed to be patentable over Solbright. In addition, Claims 2 to 10 and 31 to 33, which depend from Claim 1, are also believed to be patentable over Solbright for at least the same reasons.

Furthermore and with respect to Claim 2, a modified integrated ad file is created by combining a received modified ad input file representing a change to the content of an ad with the conduit file. Claim 3 recites steps of receiving a modified conduit file representing a change to the tracking data, combining the modified conduit file with the ad input file to create a modified integrated ad file, and serving the modified integrated ad file, to provide an ad having the changed tracking data.

The Office Action concedes that Solbright fails to teach or to suggest a modified ad file or conduit file, and further fails to teach or suggest receiving a modified ad file or conduit file. The Office Action alleges that:

“it would have been obvious to one of ordinary skill in the art at the time of the subject matter to known [sic] that the designer or programmers of Solbright would accept a new or modified information or content from the source and insert the same or different tracking information according to the goals of the campaign or the preference of the tracking server.”

According to the description provided by Solbright and in view of the concessions made in the Office Action, however, any modifications made in Solbright must be made by a programmer editing the Flash ad. There is nothing in Solbright that corresponds to the claimed conduit file, and/or combining the claimed conduit file and an ad input file to create an integrated ad file. It follows then that nothing in Solbright corresponds to creating a modified integrated ad file by combining a modified ad input file with a conduit file (Claim 2) or by combining an ad input file with a modified conduit file (Claim 3). To the extent that the Examiner is relying on

“Officially Noticed” facts, the Applicant hereby traverses such Official Notice based at least on the above discussion and the concessions made in the Office Action, and specifically requests the Examiner to provide documentary evidence of any such “Officially Noticed” facts, should the Examiner maintain the rejection. For similar reasons, the Applicant traverses the rejection of Claims 13, 14, 22, 23 and 28, and requests that the Examiner provide documentary evidence of each Officially Noticed fact, should the Examiner maintain her rejection of these claims.

With reference to the Officially Noticed facts, Applicant’s current and previous responses include a request that the Examiner provide evidence to substantiate the Officially Noticed facts. The Examiner has refused to provide the requested substantiation based on a conclusion by the Examiner that Applicant’s request was insufficient. It is clear from MPEP § 2144.03 and the caselaw¹ provided therein that the Applicant’s request/response was more than sufficient. Furthermore and as is also made clear in MPEP § 2144.03, Official Notice is only appropriate in a limited number of circumstances and should only be taken where the facts asserted to be well-known or common knowledge are capable of instant and unquestionable demonstration as being well-known or common knowledge. It should not be used simply as a matter of convenience.

As is made clear from MPEP § 2144.03 and caselaw, the Applicant’s response was more than sufficient to challenge the unsubstantiated assertions made in the previous Office Action, and such documentary evidence of the facts Officially Noticed should have been provided with the current Office Action. The Applicant renews the traversal of the Official Notice taken in the previous and current Office Actions, and further renews the request for the documentary evidence of the facts Officially Noticed in the § 103(a) rejection of Claims 2, 3, 5, 6, 11 to 28, 31 and 32, should the Examiner maintain the § 103(a) rejection of these claims.

Referring to Claim 5, the ad input file includes an empty movie clip object such that the combining of an ad input file with a conduit file to create an integrated ad file recited in Claim 1 includes inserting the conduit file into the empty movie clip object. Claim 6 depends from Claim 5, and further recites that the empty movie clip object is given a predefined name and combining

¹ For example and in view of the position taken by the court in *In Re Chevenard*, 139 F.2d at 711, 60 USPQ at 239 (CCPA 1943), something more than a total absence of some demand is sufficient, and that such a response would be more than sufficient to prompt the examiner to produce authority for her assertions in response.

the ad input and conduit file includes searching the ad input file for the predefined name and inserting the conduit file into the empty movie clip with the predefined name.

In rejecting Claims 5 and 6, the Office Action concedes that Solbright fails to teach or to suggest an ad input file that includes an empty movie clip object, fails to teach or to suggest inserting a conduit file in the empty movie clip object, fails to teach or to suggest an empty movie clip object having a predefined name, and further fails to teach or to suggest searching the ad input file for the predefined name of the empty movie clip object. The Office Action then assumes “Officially Noticed” facts, and alleges that such facts somehow suggest each and every one of the elements of Claims 5 and 6 not disclosed or taught by Solbright. In view of the complete absence of any teaching or suggestion in Solbright with respect to multiple elements of Claims 5 and 6, as conceded in the Office Action, the Applicant traverses the Official Notice taken in the Office Action. Should the Examiner maintain the rejection, the Applicant respectfully requests that the Examiner provide evidentiary support for the “Officially Noticed” facts, and requests that the Examiner provide documentary evidence with respect to the claimed empty movie clip object of the ad input file into which the claimed conduit file is inserted, combining an ad input file and a conduit file by inserting the conduit file into the empty movie clip of the ad input file, searching the ad input file for a predefined name of the empty movie clip of the ad input file, and combining an ad input file to create an integrated ad file by inserting the conduit file into the empty movie clip having the predefined name in the ad input file.

With respect to Claims 7 to 10, the Office Action alleges that pages 18 to 20 of Solbright teach an ad input file specifying one or more button actions, each of which has an exit code (Claim 7); a conduit file (Claim 8), or JavaScript file (Claim 9), which includes code that determines whether an ad opens in a parent window or a new window using a variable included in HTML code used to serve the integrated ad file; and tracking an ad using code in the claimed conduit file and a tracking identifier included in HTML code serving the claimed integrated ad file (Claim 10). A review of the portion of Solbright generally referenced in the Office Action fails to uncover any portion of Solbright that discloses or suggests at least the above-identified elements of Claims 7 to 10. Should the Examiner maintain the § 102(b) rejection of Claims 7 to 10 over Solbright, the Examiner is respectfully requested to identify the particular portions and

elements of Solbright that the Examiner considers teaches each and every one of the elements recited in Claims 7 to 10.

With regard to Claims 11, 12, 15 to 21, 16 and 24 to 27, the Office Action contends (commencing at page 5) that:

“Solbright teaches identifying a first file (flash ad); identifying a second file (tracking information); wherein the first file specifies ad content code and the second file contains ad-tracking code; creating an ad file including computer code for providing the ad; wherein the first file specifies ad content code and the second file contains an ad-tracking code; html code loading ad file (third file); third file including one or more buttons; creating the [sic] (see pp 17-20). Solbright does not explicitly teach identifying a placeholder (an empty movie clip) in the first file and electronically inserting the second file in the placeholder to create an ad file. However official notice is taken that [it] is old and well known in the art of programming to create an empty movie clip using Macromedia Flash. Macromedia Flash is used to create an empty movie clip, one that contains no data or graphic content, so that external files (JPGS or SWF) can be loaded into it. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the subject matter to create an empty movie clip, in rich media, as a placeholder for external files such as the tracking data to be inserted into it, if the ad is a movie clip.”

With regard to the Official Notice taken in the Office Action, the Applicant respectfully submits, as is clearly set forth in MPEP § 2144.03, that Official Notice is only appropriate in a limited number of circumstances and should only be taken where the facts are capable of instant and unquestionable demonstration as being well known or common knowledge. It should not be used simply as a matter of convenience. The Applicant traverses the Official Notice taken in the Office Action. Should the Examiner maintain her rejection of the claims based on Officially Noticed facts, the Applicant respectfully requests that the Examiner provide documentary

support for each fact Officially Noticed. The requested documentary support is particularly important in view of the Examiner's own admission in her grounds for rejecting Claims 2, 3, 5, 6, 11 to 28, 31 and 32, in which the Examiner concedes that the only documentary evidence of record relied on to make the § 103(a) rejection of these claims fails to teach, suggest or disclose multiple elements of these claims.

With regard to independent Claims 11, 16 and 24, the Examiner concedes that Solbright fails to teach or suggest a placeholder in a file, identifying a placeholder in a first file and electronically inserting a file in the placeholder to create an ad file, it is clear that Solbright's approach cannot teach, suggest or disclose the methods of Claim 11, 16 or 24. The Applicant traverses the Official Notice taken by the Examiner in rejecting Claims 11, 12, 15 to 21 and 24 to 27, including any "Officially Noticed" facts that the Examiner alleges disclose or suggest inserting one or more file into a respective placeholder identified in another file to create an ad file, as recited in Claims 11, 16 and 24. In addition, the Applicant traverses the Official Notice taken by the Examiner in rejecting Claims 12, 15, 17 to 21 and 25 to 27, including any Officially Noticed facts that the Examiner alleges teach, disclose or suggest the elements of these claims, including inserting a file that contains ad-tracking code into the placeholder identified in another file which specifies ad content code to create an ad file (Claim 12); a placeholder into which a file is inserted to create an ad file comprises an empty movie clip (Claims 15, 17, 27); combining first and second files into first and second placeholders in a third file to create an ad file, the third file including one or more buttons corresponding to links to one or more web pages, and wherein HTML code specifies URLs for the one or more web pages (Claim 19); using an executable program (Claim 20), or a web-based application (Claim 21) to insert first and second files into first and second placeholders in a third file; inserting a conduit file into a placeholder identified in an ad input file to create an integrated ad file (Claim 25); and inserting a conduit file created using Flash into a placeholder identified in an ad input file created using Flash to create an integrated ad file (Claim 26). Should the Examiner maintain her rejection of Claims 11, 12, 15 to 21, 16 and 24 to 27, she is respectfully requested to provide documentary support for each Officially Noticed fact.

Claim 31, depends from Claim 24, and further recites that the integrated ad file includes one or more exit codes referring to one or more URL variables. Claim 32, which depends from

Claim 31, further recites that the integrated ad file is designed to be loaded by code, the code specifying one or more URLs corresponding to the one or more URL variables referred to by the one or more exit codes included in the integrated ad file, the code populating the one or more URL variables with the one or more URLs.

In rejecting Claims 31 and 32, the Office Action generally cites pages 17 to 20 of Solbright. Upon a review of the cited portion of Solbright, nothing was found that can be said to teach, suggest or disclose one or more exit codes referring to one or more URL variables, and/or an integrated ad file that is to be loaded by code that specifies one or more URLs corresponding to one or more URL variables, the code populating the one or more URL variables with the one or more URLs. Should the Examiner maintain the grounds for rejection of these claims, the Applicant respectfully requests that the Examiner provide specific references to the components and portions of Solbright that the Examiner considers correspond to each and every element recited in Claims 31 and 32.

For at least the foregoing reasons and the concessions made in the Office Action, Solbright is missing multiple elements of each of Claims 1 to 28 and 31 to 33. Solbright cannot therefore form the basis for a § 102 rejection, and reconsideration and withdrawal of the § 102(b) rejection of the claims so rejected are respectfully requested. Furthermore, Solbright cannot form the basis for a §103(a) rejection of the claims, as the record is devoid of a teaching of the missing elements.

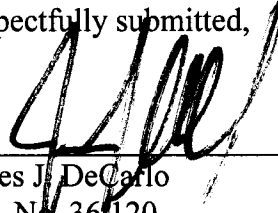
In view of the foregoing, the entire application is believed to be in condition for allowance, and such action is respectfully requested at the Examiner's earliest convenience.

Should matters remain which the Examiner believes could be resolved in a telephone interview, the Examiner is requested to telephone the Applicant's undersigned attorney. Alternatively, since it is believed that the claims of the present application are in condition for allowance, the Examiner is respectfully requested to issue a Notice of Allowance at the Examiner's earliest convenience.

The Applicant's attorney may be reached by telephone at 212-801-6729. All correspondence should continue to be directed to the address given below, which is the address associated with Customer Number 76058.

The Commissioner is hereby authorized to charge any required fee in connection with the submission of this paper, any additional fees which may be required, now or in the future, or credit any overpayment to Account No. 50-1561. Please ensure that the Attorney Docket Number is referenced when charging any payments or credits for this case.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'James J. DeCarlo', is written over a horizontal line.

James J. DeCarlo
Reg. No. 36,120

Date: August 5, 2008

Customer Number 76058
GREENBERG TRAURIG, LLP
Met Life Building
200 Park Avenue, 20th Floor
New York, New York 10166
Phone: (212) 801-9200
Fax: (212) 801-6400